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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/895,469

06/29/2001

Scott P. Dubal

42390P11385

6532

8791

7590

08/09/2004

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EXAMINER

COURTENAY III, ST JOHN

ART UNIT

PAPER NUMBER

2126

DATE MAILED: 08/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/895,469

Applicant(s)

DUBAL, SCOTT P.

Examiner

St. John Courtenay III

Art Unit

2126

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 5-28 is/are allowed.
- 6) ☒ Claim(s) 1-4 and 29-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.


## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

  
ST. JOHN COURTENAY III  
PRIMARY EXAMINER

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### **Detailed Action**

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002 do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1 & 4 are rejected under 35 U.S.C. § 102(e) as being anticipated by **Lin et al.** (U.S. Patent 6,345, 319).

#### **As per independent claim 1:**

**Lin** teaches a method comprising:

- accessing configuration information of a first type for a device connected to a bus [see "Read hardware device ID 123", step 202 Fig. 2, see associated discussion col. 3, beginning line 1];
- accessing configuration information of a second type for the device [see "Retrieving a device class from the data registry 12 of the Windows System, step 206, Fig. 2., see associated discussion col. 3, beginning line 26; see associated discussion col. 3, beginning line 13];

- comparing a memory location of the configuration information of the first type to a memory location of the configuration information of the second type [see Fig. 2, step 208, "Determine whether the original ID 121 is same as the ID 123 of the device being installed, see associated discussion col. 3, beginning line 26]; and
- selecting the configuration information of the first type if the memory location of the configuration information of the first type matches the memory location of the configuration information of the second type [see Fig. 2, step 209, see associated discussion col. 3, beginning line 31].

**As per dependent claim 4:**

**Lin** teaches selecting the configuration information further comprises storing the configuration information [see "copy the driving and set-up (INF) files to the corresponding directory" col. 2, line 12].

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 2 & 3 are rejected under 35 U.S.C. 103(a) as being unpatentable over **Lin et al.** (U.S. Patent 6,345, 319) in view of **Jaffrey** (U.S. Patent 6,591,358).

**As per claims 2 & 3:**

**Lin** discloses the invention substantially as claimed, as discussed above.

However, **Lin** does not *explicitly* teach the following additional limitations:

**Jaffrey** teaches the notoriously well known use of a Peripheral Component Interconnect (PCI) bus and a Universal Serial Bus (USB) [e.g, see PCI bus, col. 1, line 2, and USB bus, col. 10, line 2].

It would have been obvious to one of ordinary skill in the art at the time the invention was made to improve upon the system taught by **Lin** by implementing the improvements detailed above because it would provide **Lin's** system with the enhanced capability of compatibility with the many PCI cards and USB devices that are widely available for use with a personal computer.

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 29-32 are rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. The claimed "device driver" (see preamble of independent claim 29) is a computer program, per se, that is not claimed as being embodied upon a computer readable medium, and therefore is considered as non-statutory printed matter. A device driver is entirely software, and has no hardware component.

In light of In re Lowry, to be considered statutory subject matter the claimed functional descriptive material (i.e., device driver) must be structurally and functionally interrelated to the medium and provide tangible benefits. In re Lowry 32 USPQ2d 1031 (CAFC 1994).

The Examiner suggests that Applicant amend the preamble of independent claim 29 to overcome the rejection as follows:

"A device driver in a computer system: ..."

or

"A device driver embodied upon a computer-readable medium: ..."

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**Allowable Subject Matter:**

*Claims 5 -28 appear to be allowable over the prior art of record, subject to the results of a final search.*

**Prior Art not relied upon:**

Please refer to the references listed on the attached PTO-892 which are not relied upon in the claim rejections detailed above.

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**How to Contact the Examiner:**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to St. John Courtenay III, J.D., M.B.A., whose telephone number is 703-308-5217. A voice mail service is also available at this number. The examiner can normally be reached on M - F 7:30 AM - 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, An Meng-AI who can be reached on 703-305-9678. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

**All responses sent by U.S. Mail should be mailed to:**

Commissioner for Patents  
PO Box 1450  
Alexandria, VA 22313-1450

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**Patent Customers advised to FAX communications to the USPTO**

<http://www.uspto.gov/web/offices/pac/dapp/opla/preognotice/faxnotice.pdf>

Effective Oct. 15, 2003, ALL patent application correspondence transmitted by FAX must be directed to the new PTO central FAX number:

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**NEW PTO CENTRAL FAX NUMBER:  
703-872-9306**

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- Any inquiry of a general nature or relating to the status of this application should be directed to the **TC 2100 Group receptionist: (703) 305-3900.**

**Please direct inquiries regarding fees, paper matching, and other issues not involving the Examiner to:**

**Technical Center 2100 CUSTOMER SERVICE: 703 306-5631**

The Manual of Patent Examining Procedure (MPEP) is available online at: <http://www.uspto.gov/web/offices/pac/mpep/index.html>



ST. ST. JOHN COURTENE  
PRIMARY EXAMINER